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EXAMINER

WALLENHORST, MAUREEN

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT H. WOLLENBERG
and THOMAS J. BALK

Appeal 2007-0511
Application 10/699,508¹

Decided: 19 February 2008

Before FRED E. McKELVEY, *Senior Administrative Patent Judge*, and
ADRIENE LEPIANE HANLON and MICHAEL P. TIERNEY,
Administrative Patent Judges.

HANLON, *Administrative Patent Judge*.

DECISION ON REHEARING

The Appellants request rehearing of a Decision on Appeal dated September 20, 2007. The Decision affirmed all of the rejections on appeal. See Decision 26-27.

On rehearing, the Appellants argue that the Board misapprehended or overlooked two points. *See* 37 C.F.R. § 41.52(a)(1) (2007).

¹ Application 10/699,508 was filed on October 31, 2003. The real party in interest is said to be Chevron Oronite Company LLC.

I.

The Appellants argue that the Board erred in concluding that claim 1 does not require an automated step for measuring oxidation stability. See Decision 16-17. Similarly, the Appellants argue that the Board erred in concluding that claim 15 does not require an automated means for measuring oxidation stability. See Decision 18.

According to the Appellants, the entire high throughput method and system for screening lubricating oil composition samples is automated. The Appellants rely on lines 11-14 on page 4 of the Specification and lines 15-18 on page 26 of the Specification to support their argument. Request 2.

“[T]he name of the game is the claim.” *In re Hiniker Co.*, 150 F.3d 1362, 1369 (Fed. Cir. 1998).

Claim 1 reads, in relevant part, as follows:

A high throughput method for screening lubricating oil compositions, under program control, comprising . . .

(b) measuring the oxidation stability of each sample to provide oxidation stability data for each sample

Claim 15 reads, in relevant part, as follows:

A system for screening lubricating oil composition samples, under program control, comprising . . .

d) means for measuring the oxidation stability of the selected samples to obtain oxidation stability data and for transferring the oxidation stability data to the computer controller.

According to the Appellants' Specification, the term “high throughput” means “that a relatively large number of different lubricating oil compositions [are] rapidly prepared and analyzed.” Specification 5:8-10; see also Decision 5:9-11. The Appellants define “program control” as

meaning that “the equipment used herein in providing the plurality of lubricating oil compositions is automated and controlled by a microprocessor or other computer control device.” Specification 5:19-21; see also Decision 6:8-11. The Appellants’ Specification describes the means for measuring oxidation stability as including “subjecting the sample to an oxygen environment and measuring the effect of oxidation upon the sample over a predetermined period of time.” Specification 24:10-12; see also Decision 17:16-18:14.

Significantly, the Appellants do not argue that the Board overlooked or misapprehended any language in claim 1 that requires step (b) to be automated. Likewise, the Appellants do not argue that the Board overlooked or misapprehended any language in claim 15 that requires the means for measuring oxidation stability to be automated.² To the extent that the Appellants’ Specification *discloses* a high throughput method wherein the step of measuring oxidation stability may be automated, limitations from the Appellants’ Specification will not be read into the claims. *E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 1433 (Fed. Cir. 1988).

II.

The Appellants argue that the Board erred in finding that the lubricant composition disclosed in Kolosov would have been expected to contain a major amount of a base lubricant oil and a minor amount of an additive. The Appellants argue that “a lubricating oil composition can be a concentrate that contains *a major amount of a lubricating oil additive and a minor amount of base oil of lubricating viscosity* as a diluent for the concentrate.”

² The limitations recited in items b) and c) in claim 15 were not at issue on appeal.

The Appellants argue that this argument was overlooked on appeal. The Appellants also point to *Chemistry and Technology of Lubricants* 88 (R.M. Mortier & S.T. Orszulik, eds., 2nd ed. 1997) for the first time on appeal to support their argument. Request 3-4.

First, *Chemistry and Technology of Lubricants* is not entitled to consideration on rehearing. 37 C.F.R. § 41.52(a)(1) (2007). Second, the Appellant's argument was not overlooked on appeal. Indeed, the Board found (Decision 20):

Kolosov does not expressly disclose that the lubricants comprise a major amount of at least one base oil of lubricating viscosity and a minor amount of at least one lubricating oil additive. However, the record before us establishes that one of ordinary skill in the art would have understood “additive” to mean any substance incorporated into a base material, usually in a low concentration. See *The Condensed Chemical Dictionary* at 20 [(10th ed. 1981)]; see also O’Rear, paras. [0002] and [0046]; Gatto, para. [0051]. We find that one of ordinary skill in the art would have reasonably expected the lubricant compositions in Kolosov, comprising a lubricant and an additive, to have a major amount of a base oil and a minor amount of an additive.

On rehearing, the Appellants have failed to point to any error in these findings. The mere offer of an alternative definition for “additive” does not sufficiently explain why, in the context of the Kolosov invention, the Board erred.

Finally, the Appellants argue that a lubricating oil composition would not be expected to contain a major amount of at least one base oil of lubricating viscosity and a minor amount of at least one lubricating oil additive “each and every time.” Request 4. However, the Board did not make such a finding. See Decision 19-20.

Conclusion

The Appellants' request for rehearing has been granted to the extent that the Decision on Appeal dated September 20, 2007, has been reconsidered in light of the Appellants' arguments. However, the request is denied because we decline to modify the decision in any respect.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a) (2007).

REHEARING DENIED

cc (via U.S. Mail):

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